

REMARKS

Reconsideration of this application is respectfully requested. The specification has been amended to clarify that parent application 09/147,919 was the National Stage of a PCT application with an actual U.S. filing date of September 23, 1997. Claim 1 has been amended. The amendment is supported throughout the specification, for example, on page 8, line 14. Claims 11-34 have been canceled. Claims 35-46 are new and are derived from canceled claims 11-34. No new matter enters through this amendment.

Claims 18, 19, 33, and 34 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicants traverse the rejection.

Support for claims 18 and 19 can be found throughout the specification, for example, on page 10, paragraphs 3-4, and on pages 21-22, in original claims 9-10, which describe the combination of an MVA encoding T7 polymerase with a T7 promoter/dengue antigen construct and inoculation into a host. Support for claims 33 and 34 can also be found throughout the specification, for example, recombination into MVA is exemplified on pages 15-19 in Examples 5-9.

Moreover, claims 18, 19, 33, and 34 have been canceled. Accordingly, this rejection is moot.

Claims 15, 17-20, and 33-34 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Applicants traverse the rejection.

The Examiner provides no evidence to support a conclusion that undue experimentation would be required to use applicants' claimed pharmaceutical compositions of claims 15 and 18. Al'tshtein et al. does not provide evidence that the composition of claim 11 could not be used as a vaccine. Al'tshtein et al. does comment that "double recombinants expressing T7 polymerase and containing the T7 promoter are not viable." (At 20.) However, Al'tshtein et al. does not address the use of an MVA/T7 polymerase construct and a separate T7 promoter/dengue antigen construct as a vaccine.

Moreover, claims 15, 17-20, and 33-34 have been canceled. Accordingly, this rejection is moot.

Claims 1 and 11-34 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Cardoso et al., WO 98/13500, published on April 2, 1998. The Examiner contends that applicants' only claimed priority date is March 23, 1999. Applicants traverse the rejection.

The Examiner has assigned the wrong U.S. filing date to applicants' parent application. Applicants claimed priority to U.S. Appln. 09/147,919, which was assigned a U.S. filing date of March 23, 1999, by the PTO. However, this date is simply the date of entry of the application into the National Stage. Since Appln. 09/147,919 is a National Stage application of International Application No. PCT/EP97/05214, filed September 23, 1997, it has an actual "U.S. filing date" of September 23, 1997, the filing date of the international application. Applicants have amended the specification to clarify this point.

The M.P.E.P. supports a conclusion that September 23, 1997, is the correct filing date for U.S. Appln. 09/147,919. As stated in M.P.E.P. § 1893.03(b):

An international application designating the U.S. has two stages (international and national) with the filing date being the same in both stages. Often the date of entry into the national stage is confused with the filing date. It should be borne in mind that the filing date of the international stage application is also the filing date for the national stage application.

Moreover, a decision of the Court of Appeals for the Federal Circuit is directly on point. In *Broadcast Innov. LLC v. Charter Comm, Inc.*, the Court of Appeals faced the issue of what was the proper filing date for a U.S. patent that claimed priority to a U.S. National Stage application, but did not specifically reference the PCT application. 76 U.S.P.Q. 2d 1220, 1221 (Fed. Cir 2005). The court found that the filing date of the PCT application was the proper "U.S. filing date," and not the entry date of the application into the U.S. National Stage. *Id.* at 1222-1223. Accordingly, the court concluded that the publication of the PCT application did not anticipate the claims issuing from the National Stage application under § 102(b). *Id.* at 1223. The same is true in the present case.

In the present application, the "U.S. filing date" of U.S. Appln. 09/147,919 is September 23, 1997, and the publication of the PCT application cannot anticipate applicants' claims. Since WO98/13500 was published **after** applicants' effective U.S. filing date of September 23, 1997, it is not effective prior art. Accordingly, applicants respectfully request withdrawal of the rejection.

Applicants respectfully submit that this application is now in condition for allowance. If the Examiner believes that issues remain to be addressed before a Notice

of Allowance, applicants respectfully request that the Examiner contact the undersigned to discuss any outstanding issues.

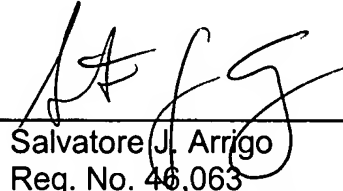
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 14, 2006

By: _____


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